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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,233	07/13/2000	AKITOSHI KOJIMA	P-9904 S	1035

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EXAMINER
MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
2131	8

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/555,233	KOJIMA, AKITOSHI
	Examiner	Art Unit
	Aravind K Moorthy	2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 April 2004*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

     4a) Of the above claim(s) *9-11* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 June 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1. Claims 1-11 are pending in the application.

2. Claims 1-8 stand being rejected.

3. Claims 9-11 have been cancelled.

Response to Amendment

4. The examiner approves the new title.

5. With the amendments to the claims, the claims are now statutory. The examiner withdraws claim Rejections 35 USC § 101.

Response to Arguments

6. Applicant's arguments filed 4/26/04 have been fully considered but they are not persuasive.

On page 9, the applicant argues that Lin et al does not teach a parallel provider that makes a roaming contract with the individual service providers.

The examiner respectfully disagrees. In response to applicant's arguments, the recitation "makes a roaming contract with the plurality of individual service providers" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

On page 9, the applicant argues that Partridge does not determine whether the user is a member of an individual service provider or a member of a parallel service provider that is

connected to the plurality of individual service providers and that makes a roaming contract with

the plurality of individual service providers.

The examiner respectfully disagrees. Partridge teaches visitors using the home CGSA.

The visitors would constitute roamers of an individual service provider.

On page 9, the applicant argues that the "Wayback Machine" does not teach or suggest

than electronic mail address, including a combination of sub-domain not registered, and a user

name set.

The examiner respectfully disagrees. The examiner asserts anytime a user tries to

authenticate himself in hotmail, hotmail verifies the electronic mail address that includes a sub-

domain.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

7. Claims 1-3 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Lin et al

U.S. Patent No. 56,282,575 B1.

As to claim 1, Lin et al suggests an article of manufacture comprising a computer usable medium having computer readable program code means embodied therein, the computer readable program code means for a network system comprising a plurality of individual service providers each having access points [column 4, lines 34-45]. Lin et al discloses a parallel service provider connected to the plurality of individual service providers, makes a roaming contact with the plurality of individual service providers and including an authentication server [figure 2 and accompanying description]. Lin et al discloses computer readable program code means for causing a computer the access point of the individual service providers receives a connection request from a user who contracts with the parallel service provider, the providers cause the authentication server to perform user authentication and computer readable program code means for causing a computer to connect the user to a network through the access point in accordance with a result of the authentication [column 4, lines 34-45].

As to claim 2, Lin et al discloses that the user who contracts with the parallel service provider send a connection request containing a domain name of the parallel service provider to the access point [column 4, lines 34-45]. Lin et al discloses that the access point determines whether the user contracts with the parallel service provider in accordance with presence or absence of the domain name [column 2, lines 1-10].

As to claim 3, Lin et al suggests that the parallel service provider is connected to the plurality of individual service providers through an exclusive line [figure 2 and accompanying description].

As to claim 9, Lin et al discloses a connection request issued from a user [figure 3 and accompanying description]. Lin et al discloses determining whether the user is a regular member of a provider with which the user contracts or a partnership member under a given contract with the provider [figure 3 and accompanying description]. Lin et al discloses that when the user is a regular member, executing user authentication processing and connecting the user to a network in accordance with a result of the authentication processing [figure 3 and accompanying description]. Lin et al discloses that when the user is a partnership member, transferring a connection request to a specified authentication server, and executing user authentication processing and connecting the user to the network in accordance with a result of the authentication processing [column 4, lines 34-45].

As to claim 10, Lin et al discloses that the partnership member inserts a predetermined domain name in the connection request [column 2, lines 1-10]. Lin et al discloses that the determining means determines whether the user is the partnership member in accordance with presence or absence of the domain name in the connection request [figure 3 and accompanying description].

As to claim 11, Lin et al suggests that the specified authentication server is connected to network connection devices of a plurality of companies and used in common [figure 2 and accompanying description].

8. Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Partridge, III U.S. Patent No. 5,384,848 (hereinafter Partridge).

As to claim 5, Partridge discloses computer readable program code means for causing a computer to send a connection request from a user to an access point of any one of a plurality of

individual service providers [column 7, lines 45-52]. Partridge discloses computer readable

program code means for causing a computer to determine by the access point whether the user is

a member of an individual service provider including the access point or a member of a parallel

service provider that is connected to the plurality of individual service providers and makes a

roaming contract with the plurality of individual service providers [column 3, lines 18-35].

Partridge discloses computer readable program code means for causing a computer to execute

user authentication processing by the access point itself when the user is a member of the

individual service provider [column 3 line 40 to column 4 line 48]. Partridge discloses

connecting the user to a network in accordance with a result of the authentication processing

[column 3 line 40 to column 4 line 48]. Partridge discloses computer readable program code

means for causing a computer to cause the parallel service provider to execute user

authentication processing when the user is a member of the parallel service provider [column 4

line 43 to column 5 line 47]. Partridge discloses connecting the user to the network in

accordance with a result of the authentication processing [column 4 line 43 to column 5 line 47].

As to claim 6, Partridge suggests that the user who contracts with the parallel service

provider send a connection request containing a domain name of the parallel service provider to

the access point [figure 2 and accompanying description]. Partridge discloses that the access

point determines whether the user contracts with the parallel service provider in accordance with

presence or absence of the domain name [figure 2 and accompanying description].

9. **Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Wayback Machine.**

As to claim 8, Wayback Machine suggests computer readable program code means for

causing a computer when a user name is input, determining whether an electronic mail address

including a combination of the user name and any one of a plurality of predetermined sub-domains has been registered. Wayback Machine suggest computer readable program code means for causing a computer to when the electronic mail address has been registered, determining an electronic mail address including a combination of the user name and another sub-domain has been registered, whereby setting an electronic mail address and including a combination of a sub-domain not registered and a user name.

The examiner asserts that Wayback Machine was used to show that hotmail was in use prior to the priority date. The examiner asserts that hotmail determines whether an electronic mail address including a combination of the user name and any one of a plurality of predetermined sub-domains has been registered. Hotmail also determines an electronic mail address including a combination of the user name and another sub-domain has been registered, whereby setting an electronic mail address and including a combination of a sub-domain not registered and a user name.

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Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Partridge, III U.S. Patent No. 5,384,848 (hereinafter Partridge) as applied to claims 1 and 5 above, and further in view of Carnegie et al U.S. Patent No. 5,745,884.

As to claims 4 and 7, Partridge does not teach that the plurality of individual service providers sends respective user connection recordings to the parallel service provider.

Carnegie et al teaches that service providers send respective user connection recordings to the parallel service provider [figure 3 and accompanying description].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Partridge so that the service providers would have sent out user connection recordings to the parallel service provider.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Partridge by the teaching of Carnegie et al because it helps operators of such networks to facilitate collection of revenues for service [column 3, lines 47-54].

Conclusion

11.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
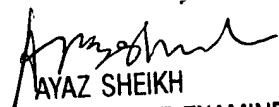
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K Moorthy whose telephone number is 703-305-1373. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy
July 8, 2004

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